

REMARKS

In the Office Action,¹ the Examiner :

- (a) required restriction under 35 U.S.C. § 121 and 372;
- (b) rejected claims 1-14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- (c) rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki et al. (U.S. Patent Publication No. 2003/0153958) ("Yamazaki") in view of Ya Man LTD (JP 2000-060977) ("Ya Man LTD"); and
- (d) rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki in view of Ya Man LTD, and further in view of Granek et al. (U.S. Patent No. 4,729,377) ("Granek").

Applicants amend claims 1, 7, and 8 to improve form and clarity. Upon entry of this Amendment, claims 1-14 remain pending, with claims 15-20 withdrawn from consideration as drawn to a nonelected invention. Applicants respectfully traverse the rejection for the following reasons.

Restriction under 35 U.S.C. § 121 and 372:

The Examiner required election under 35 U.S.C. § 121 and 372 of one of the following groups: Group I, claims 1-14, characterized by the Examiner as drawn to an electrode for applying stimulation to the body; and Group II, claims 15-20, characterized by the Examiner as drawn to a device for applying stimulation to the body. Applicants affirm the previous oral election to prosecute Group 1, claims 1-14.

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Rejection of Claims 1-14 under 35 U.S.C. § 112, second paragraph:

The Examiner rejected claims 1-14 under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (Office Action, p. 3).

In response, Applicants have amended claims 1, 7, and 8 to overcome the rejection. Applicants therefore request withdrawal of the rejection of claims 1, 7, and 8 under 35 U.S.C. § 112, second paragraph. Applicants also request withdrawal of the rejection of dependent claims 2-6 and 9-14 under 35 U.S.C. § 112, second paragraph.

Rejection of Claims 1-13 under 35 U.S.C. § 103(a):

Applicants traverse the rejection of claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki in view of Ya Man LTD. No *prima facie* case of obviousness has been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145*. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966)... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Here, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 1 calls for a combination including, for example, “[a]n electrode for treatment ... comprising: ... a receiving means for receiving a control signal proper for said treatment electrode transmitted from said controller at radio transmission; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said control signal received by said receiving means at radio transmission” (emphasis added). The cited references fail to teach at least this element of claim 1.

Yamazaki discloses that “[t]hose planar electrodes H1, H2, H3 and H4 are to contact to the approximation of the waist of the user” (para. [0054]). Yamazaki further discloses that “[t]hose button projections 6 correspond to a button recess 7 connecting a cable 59 and cable 3 with detachable structure. Therefore, the planar electrodes H1, H2, H3 and H4 are connected electrically to a control unit 2 through the button projection 6, button recess 7, cables 59 and 3” (para. [0055]). However, Yamazaki does not teach not suggest “a receiving means for receiving a control signal proper for said treatment electrode transmitted from said controller at radio transmission,” as recited in claim 1.

The Examiner admitted that “Yamazaki does not disclose a receiving means for receiving an external control signal at radio transmission” (Office Action, p. 4). The Examiner then alleged that Ya Man LTD teaches “an electrode treatment device that contains a portable control unit 1 that transmits control signals via a transmission antenna to a receiving antenna on the treatment apparatus in order to control the stimulation given by an electrode belt (Abstract)” (Office Action, p. 4).

However, this does not constitute “[a]n electrode for treatment ... comprising: ... a receiving means for receiving a control signal proper for said treatment electrode transmitted from said controller at radio transmission,” as recited in claim 1 (emphasis added). For example, in embodiments in Applicants' specification (e.g., para. [0024] - [0027] and Figs. 1-4), the control signal is directly transmitted from the transmitting antenna 8 of the controller 6 to the antenna 12 of the electrode. In such embodiments, the control signal directly controls the treatment electrode.

Ya Man LTD is directed at “a cordless type beauty treatment pulse unit” (Title).

Ya Man LTD discloses that “[t]his beauty treatment pulse unit comprises a control box 1, a pulsed power source 2, a belt electrode 3 ... and a tights electrode 4” (Abstract).

Ya Man LTD also discloses that “[t]he control box 1 converts a treatment type designated via its color liquid crystal panel P and the associated feed pattern into control signals, and sends them to the pulsed power source 2 via a transmission antenna 12” (Abstract). Ya Man LTD further discloses that “[u]pon receiving the control signals via a reception antenna 22, the pulsed power source 2 generates pulses of prescribed width and frequency. The belt electrode 3 has planar electrodes 32 that ... are connected to the pulsed power source 2 ... [and t]he tights electrode 4 also has planar electrodes 42 that are ... connected to the pulsed power source 2 via ... cables 44” (Abstract).

Therefore, according to Ya Man LTD, the transmission of control signals is conducted between the control box 1 and the pulsed power source 2, then the supply of the current to the belt electrode 4 is conducted between the pulsed power source 2 and the belt electrode 4 via the cables 44. However, Ya Man LTD does not teach or suggest “[a]n electrode for treatment ... comprising: ... a receiving means for receiving a control signal proper for said treatment electrode transmitted from said controller at radio transmission,” as recited in claim 1 (emphasis added).

Furthermore, according to Ya Man LTD, the belt electrode 3 is only configured as an electrode. One of ordinary skill in the art would recognize that the belt electrode 3 may not contain electric components such as “an electric power source,” “a treatment current supplying means,” or “a receiving means for receiving a control signal proper for

said treatment electrode transmitted from said controller at radio transmission," as recited in claim 1.

Therefore, neither Yamazaki nor Ya Man LTD, nor any combination thereof, teaches "[a]n electrode for treatment ... comprising: ... a receiving means for receiving a control signal proper for said treatment electrode transmitted from said controller at radio transmission; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said control signal received by said receiving means at radio transmission," as recited in claim 1 (emphasis added).

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the Office Action, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. Independent claim 1 is therefore allowable, and dependent claims 2-13 are also allowable at least by virtue of their dependence from base claim 1. The 35 U.S.C. § 103(a) rejection of claims 1-13 is therefore improper and should be withdrawn.

Rejection of Claim 14 under 35 U.S.C. § 103(a):

Applicants traverse the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki in view of Ya Man LTD, further in view of Granek. No *prima facie* case of obviousness has been established.

Claim 14 depend upon base claim 1. As explained above, neither Yamazaki nor Ya Man LTD, nor any combination thereof, teaches “[a]n electrode for treatment ... comprising: ... a receiving means for receiving a control signal proper for said treatment electrode transmitted from said controller at radio transmission; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said control signal received by said receiving means at radio transmission,” as recited in claim 1 and required by claim 14 (emphasis added).

Granek fails to cure the deficiencies of Yamazaki and Ya Man LTD. The Examiner alleged that “Granek teaches a garment apparatus for delivering and receiving electrical impulses” (Office Action, p. 7). However, whether this allegation is correct or not, neither Yamazaki nor Ya Man LTD, nor Granek, nor any combination thereof, teaches “[a]n electrode for treatment ... comprising: ... a receiving means for receiving a control signal proper for said treatment electrode transmitted from said controller at radio transmission; and a controlling means for controlling the operation of said treatment electrode through said treatment current supplying means on the basis of said control signal received by said receiving means at radio transmission,” as recited in claim 1 and required by claim 14 (emphasis added).

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the Office Action, the Office Action has neither properly determined the

scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of claim 14 is therefore improper and should be withdrawn.

Conclusion:

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 1-14 are in condition for allowance. Accordingly, Applicants request a favorable action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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